



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.          | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------|-------------|----------------------|---------------------|------------------|
| 09/662,965               | 09/15/2000  | GETHER IRICK JR.     | 05015.0365U1        | 3021             |
| 23859                    | 7590        | 11/07/2003           | EXAMINER            |                  |
| NEEDLE & ROSENBERG, P.C. |             |                      | SHORT, PATRICIA A   |                  |
| SUITE 1000               |             |                      | ART UNIT            |                  |
| 999 PEACHTREE STREET     |             |                      | PAPER NUMBER        |                  |
| ATLANTA, GA 30309-3915   |             |                      | 1712                |                  |

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

|                              |                   |              |  |
|------------------------------|-------------------|--------------|--|
| <b>Office Action Summary</b> | Application No.   | Applicant(s) |  |
|                              | 09/662,965        | IRICK ET AL. |  |
|                              | Examiner          | Art Unit     |  |
|                              | Patricia A. Short | 1712         |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-5,7,9 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5,7,9 and 24-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)           |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1712

This action is in response to the request for continued examination (RCE) and preliminary amendment filed on August 12, 2003 and refiled on September 10, 2003.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-5, 7, 9 and 24-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are inconsistent in that claim 29 recites that the biodegradable polymer or biodegradable polymer composition "consists essentially of..." while dependent claim 9 recites that the biodegradable polymer or biodegradable polymer composition "comprises...". It is not clear what is intended in claim 7, with respect to the reference to the aliphatic-aromatic copolyester. Claim 30 is inconsistent in that, in line 3, the biodegradable polymer or biodegradable polymer second-material composition "comprises..." while, in lines 9-10, the polymer or composition "consists essentially of...". Further, it is not clear what is meant by the "biodegradable polymer-second material composition". Finally, dependent claim 28 is inconsistent with claim 30 in that "comprising" is used with respect to the biodegradable polymer composition. It is suggested that applicant clarify what is intended by using the language "comprising" with respect to the biodegradable polymer composition and the language "consisting essentially of" with respect to the biodegradable polymer.

In view of applicant's arguments and the Irick Declaration, the language "consisting essentially of" is considered to exclude the sulfonated monomer of Blumenthal that would materially affect the novel and basic characteristics of the claimed invention. Therefore, the 35 U.S.C. 102/103 rejection over Blumenthal is overcome.

Application/Control Number: 09/662,965

Page 3

Art Unit: 1712

P. Short

October 30, 2003

Phone (703) 308-2395

Fax (703) 872-9306

**PATRICIA A. SHORT**  
**PRIMARY EXAMINER**

*Patricia A. Short*